



#5
J. L. B.
4-203

BOX PATENT
Attorney Docket No. 24608

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

PETER et al.

Serial No.: 09/842,175

Group Art Unit: 1732

Date Filed: April 26, 2001

Examiner: M. Eashoo

For: **METHOD AND A DEVICE FOR MANUFACTURING A FLEXIBLE STRIP OF AT LEAST TWO DIFFERENT MASSES FLOWABLE WITH THE ADDITION OF HEAT**

RESPONSE TO RESTRICTION/ELECTION REQUIREMENT

Commissioner for Patents
Washington, D.C. 20231

Sir:

This is in response to the Official Action dated March 5, 2003. The one month shortened statutory period for response is set to expire on April 5, 2003. Accordingly, this Response is timely filed.

In view of the following remarks, the Applicants respectfully request the Examiner to withdraw the pending restriction requirement and examine all claims in this application.

SUMMARY OF RESTRICTION REQUIREMENT

Invention Groups. The Examiner has required restriction of claims 1-16 to a single invention under 35 U.S.C. § 121. As the

RC 100 MAIL ROOM
APR - 1 2003

RECEIVED

basis for this restriction requirement, the Official Action states the following:

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

- I. Claims 1-6, drawn to a method of forming a flexible strip made of a biopolymer, classified in class 264, subclass 173.1.
- II. Claim 7-16, drawn to a device for forming a flexible strip, classified in class 425, subclass 380.

The inventions are distinct, each from the other because of the following reasons:

Inventions of groups I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process, such as one that does not use a biopolymer.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

PROVISIONAL ELECTION

Applicants provisionally elect Group II (claims 7-16), drawn to a device for forming a flexible strip.

TRAVERSAL

Applicants respectfully traverse the Examiner's restriction requirement.

First, the restriction requirement is traversed because the Examiner has not shown that the inventions of Groups I and II are distinct. The burden is on the Examiner to provide reasonable examples that recite material differences. (See MPEP § 806.05(e)). The Official Action states that Invention Groups I and II are distinct because, "the apparatus as claimed can be used to practice another and materially different process, such as one that does not use a biopolymer."

Applicants respectfully assert that the example recited is not a materially different process practiced by the apparatus of Group II (claim 7). Group II is drawn to a device for forming a flexible strip of at least two different masses flowable with the addition of heat. Regardless of whether a biopolymer is used by the apparatus, the process is not materially different. It is unclear to the Applicants how altering the ingredients used by the apparatus would result in a materially different process. Non-use of a biopolymer might merely result in a different end product. A different end product produced by the apparatus of Group II using the process of Group I does not prove that Inventions Groups I and II are distinct.

In addition, the independent claims of **both** Invention Groups

make reference to a biopolymer. In fact, the language in claims 1 and 7 regarding the biopolymer is identical, "in particular of a biopolymer." Thus, it is unclear why the biopolymer is considered a feature of Group I (claim 1) and not a feature of Group II (claim 7), particularly when the Official Action states that Group II claims are distinct because the process is materially different in the absence of a biopolymer.

Applicants respectfully assert that the Examiner has not met the burden to provide reasonable examples that recite material differences. Accordingly, Applicants respectfully request the Examiner reconsider and withdraw the pending restriction requirement.

Furthermore, the restriction requirement is traversed because it omits "an appropriate explanation" as to the existence of a "**serious burden**" if a restriction were not required. (See MPEP § 803). Regardless of any differences which may exist between the inventions set forth in the different groups, a complete and thorough search for the invention set forth in one group would require searching the art areas appropriate to the other group. Since a search of each of the inventions of the groups would be coextensive, it would not be a serious burden upon the Examiner to examine all of the claims in this application.

Further at the Examiner's disposal are powerful electronic

search engines providing the Examiner with the ability to quickly and easily search all of the claims. Considering that the Examiner will most likely undertake a search for the independent claims, searching for the other claims would be minimally burdensome on the Examiner. Surely a search of one group will require searching the classes and subclasses of the other groups.

Accordingly, given the overlapping subject matter, examination of both groups would not pose a serious burden because they would be coextensive. Further, the fact that various claims may fall under different U.S. Patent and Trademark Office classes does not necessarily make them independent or distinct inventions. The classification system at the U.S. Patent and Trademark Office is based in part upon administrative concerns and is not necessarily indicative of separate inventive subject matter in all cases.

Furthermore, Applicant has paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring Applicant to file divisional applications for each of the groups of claims, the Examiner would essentially be forcing Applicant to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for the claims (which would be later prosecuted in divisional applications) are not

refundable.

If the Examiner has any questions or comments regarding this matter, he is welcomed to contact the undersigned attorney at the below-listed number and address.

Respectfully submitted,
NATH & ASSOCIATES PLLC

By: 

Gary M. Nath
Registration No. 26,965
Jerald L. Meyer
Registration No. 41,194
Customer No. 20529

Date: March 28, 2003
NATH & ASSOCIATES PLLC
1030 Fifteenth Street, N.W.
Sixth Floor
Washington, D.C. 20005
Tel: (202) 775-8383
Fax: (202) 775-8396
GMN/JLM/twk:RRR - response



1732

BOX PATENT
Attorney Docket No. 24608

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

PETER et al.

Serial No.: 09/842,175

Group Art Unit: 1732

Date Filed: April 26, 2001

Examiner: M. Eashoo

For: **METHOD AND A DEVICE FOR MANUFACTURING A FLEXIBLE STRIP
OF AT LEAST TWO DIFFERENT MASSES FLOWABLE WITH THE
ADDITION OF HEAT**

TRANSMITTAL LETTER

Commissioner for Patents
Washington, D.C. 20231

Sir:

Submitted herewith for filing in the U.S. Patent and
Trademark Office is the following:

- (1) Transmittal Letter; and
- (2) Response to Restriction Requirement.

Respectfully submitted,
NATH & ASSOCIATES PLLC

By:

Gary M. Nath
Gary M. Nath
Registration No. 26,965
Jerald L. Meyer
Registration No. 41,194
Customer No. 20529

Date: March 28, 2003

NATH & ASSOCIATES PLLC
1030 15th Street, NW - 6th Floor
Washington, D.C. 20005
GMN/JLN/twk:RRR - xmittal

TC 1700 MAIL ROOM

RECEIVED
APR - 1 2003